

REMARKS

This is a full and timely response to the outstanding final Office Action mailed June 1, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

Claims 1-22 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Yan, et al. ("Yan," U.S. Pat. No. 6,003,065). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Yan reference. Applicant discusses the Yan reference and Applicant's claims in the following.

Discussion on the Merits of the Claim Rejection Under 35 U.S.C. § 102(b)

Claims 1-22 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Yan, et al. ("Yan," U.S. Pat. No. 6,003,065). Applicant respectfully traverses this rejection.

As was described in the previous Response, Yan discloses a method and system in which a host computer system and a plurality of peripheral devices (e.g., printer, camera) are each provided with a processor 106 that implements a virtual machine instruction processor 108. Yan, column 6, line 52 to column 7, line 15. The virtual machine instruction processor 108 is used to process virtual machine instructions, such

as JAVA instructions, that control operation of the various peripheral devices. Yan, column 7, lines 9-16. Yan provides a specific example in relation to a printer in column 8:

In operation, virtual machine instruction processor 214 in FIG. 2 is used in a peripheral device such as printer 102B (FIG. 1) to fetch virtual machine instructions from primary storage 216 through input-output interface 224. After retrieving the virtual machine instructions, virtual machine instruction processor 214 then executes the instructions. Executing these computer instructions enables virtual machine instruction processor 214 to retrieve data or write data to primary storage 216, display information on one or more computer display devices (not shown), receive command signals from one or more input devices (not shown), or transmit the appropriate signals through peripheral engine interface 220 causing a peripheral device to operate. These virtual machine instructions can also retrieve data or write data to secondary storage 218, host computer 102A (FIG. 1), or other peripheral devices coupled to network 100 (FIG. 1). (Yan, column 8, lines 25-39)

In view of the above, it is clear that Yan's system requires a virtual machine instruction processor. As was identified in the previous Response, however, *Applicant's claims explicitly state that no such processor is necessary*. For at least this reason, Applicant submits that Applicant's claims are allowable over Yan.

Reply to Examiner's "Response to Arguments"

In the outstanding final Office Action, the Examiner states that Applicant's arguments as to patentability over Yan are not persuasive. In particular, the Examiner states the following:

In response to applicant's argument that no such processor is required or present, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

As first matter, Applicant notes that *this statement of the law pertains to limitations that are contained in the claim preamble, not the claim body*. Specifically, MPEP § 2111.02 states the following:

Statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim.

Given that the limitation at issue is contained in the body of Applicant's claims and not the preamble, the law cited by the Examiner is not relevant to the limitation at issue.

As a second matter, the limitation at issue is *not* a mere statement of intended use. To the contrary, the limitation is an explicit limitation that cannot be ignored by the Examiner when examining the claims. With regard to claim 1, for example, recited is transmitting a device identification to the electrical device "in a universal image capture language that is executable without a virtual machine instruction

processor.” Given that this limitation appears in a method claim, a “structural difference” need not be proven. In other words, the limitation describes the manner in which the method is performed and therefore comprises an express limitation that must be given patentable weight. Furthermore, the phrase “that is executable without a virtual machine instruction processor” describes the very nature of the claimed universal image capture language. Clearly, that recitation cannot be legitimately considered to be an “intended use.”

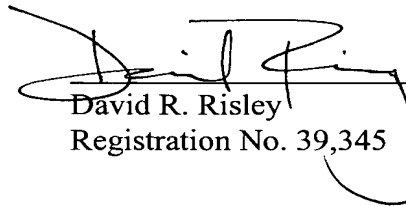
Even if one were to argue that the law cited by the Examiner were applicable and further that the limitation in question only identifies an intended use, it cannot be argued that the limitation in question does not at least recite a purpose or use that results in a “manipulative difference” between the claimed invention and the prior art (See MPEP §2111.02).

In view of the foregoing, Applicant’s recitations of a universal image capture language that is “executable without a virtual machine instruction processor” must be given patentable weight. Given that Yan does not teach a single embodiment in which a virtual machine instruction processor is not used (this is admitted by the Examiner in the third paragraph of page 2 of the final Office Action), Yan *per se* cannot anticipate Applicant’s claims.

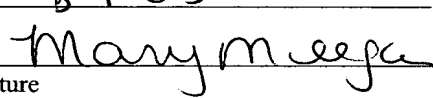
CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


David R. Risley
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

8-1-05

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